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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,506	07/18/2000	Ian J. Forster	4579-048	8845

27820 7590 12/16/2002

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EXAMINER

LEE, BENJAMIN C

ART UNIT PAPER NUMBER

2632

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,506

Applicant(s)

FORSTER ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-26, 34-46, 48-60 and 64-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-12, 14-22, 35-39, 42-46, 53-56 and 58-60 is/are allowed.
- 6) ☒ Claim(s) 7, 13, 23-26, 34, 40-41, 48-52, 57, 64 and 67-77 is/are rejected.
- 7) ☒ Claim(s) 65 and 66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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RESPONSE TO AMENDMENT

Remark Regarding Amendment

1. Applicant is hereby notified that amendment filed 10/8/02 requested cancellation of claim 47, which cancellation had been carried out on the file, and therefore subsequent request for changes to claim 47 on the same filed amendment could not, and had not been entered. Current status of claim 47 is that it had been cancelled. Furthermore, since there were 73 claims originally filed, "New claims 69-72" indicated by Applicant had been renumbered as new claims 74-77.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 13, 34 and 40 are rejected under 35 U.S.C. 112 for failing to distinctly claim the subject matter which applicant regards as the invention.

1) Claims 7 & 13, and 34 & 40, recite the same inventions, respectively.

4. Claims 48-52 and 69-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claims 48-52 depend on cancelled claim 47, making them incomplete claims and indefinite.

2) Claims 69-73 depend on cancelled claim 62, making them incomplete claims and indefinite.

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Claim Rejections - 35 USC § 103

5. Claims 23, 57, 68 and 74-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canada et al. (US pat. #5,854,994).

1) In considering claims 23 & 57, Canada et al. made obvious all of the claimed subject matter as stand in the previous Office action.

2) In considering claim 68, Canada et al. disclosed all of the following claimed subject matter:

a) claimed device (Fig. 2) that magnetically attaches (col. 11, lines 4-14) to an article (machine to be monitored), comprising: a wireless communication device using battery as power supply source (Fig. 3), and a magnetic means having a magnetic force that attaches said magnetic means to the magnetic surface portion of the article when in close proximity to the magnetic surface portion of the article (inherent from col. 11, lines 13-14; col. 5, line 39 and Fig. 2);

except

b) specifying the claimed detaching the device from the magnetic surface comprising the step of bringing said device in proximity to an external magnet to move said magnet away from the magnetic surface portion, and specifying that the magnetic means is a magnet.

However, since Canada et al. teaches that the attachment means 404 in Fig. 2 can be a "magnetic mount", it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that such magnetic mount can be implemented as a mounting via magnetic force such as a conventional permanent magnet. And while Canada et al. teaches mounting the device to a stationary machinery in a specific embodiment, it would have been obvious to one of

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ordinary skill in the art at the time of the claimed invention that the device can be mounted to any object having a magnetic surface that one desires monitoring including a portable object, and that since attachment is via magnetic force, detachment can be moving the device along with the magnet away from the magnetic surface to overcome the magnetic attraction. Furthermore the attraction and repulsion of opposing and like polarized magnetic fields, respectively, are well known, and therefore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that during detachment of the device from its attached magnetic surface, bringing the device proximate an external magnet having magnetic fields of like-polarity to the magnetic fields of the device magnet so that the device is between the two magnets, or bringing the device proximate an external magnet having magnetic fields of opposing-polarity to the magnetic fields of the device magnet so that the device magnet is situated between the device and the external magnet, would cancel out at least some of the attachment force and therefore facilitate detachment by a user.

3) In considering claims 74-77, Canada et al. disclosed all of the following claimed subject matter:

a) claimed device (Fig. 2) that magnetically attaches (col. 11, lines 4-14) to an article (machine to be monitored), comprising: a wireless communication device using battery as power supply source (Fig. 3), and a magnetic means having a magnetic force that attaches said magnetic means to the magnetic surface portion of the article when in close proximity to the magnetic surface portion of the article (inherent from col. 11, lines 13-14; col. 5, line 39 and Fig. 2);

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b) claimed detaching the device from the magnetic surface comprising the steps of receiving a message by said device, and altering said magnetic force (inherent, since the device receives messages, and since the attachment is due to magnetic force, it inherently follows that detachment requires altering of the magnetic force one way or another, wherein since the claimed limitation requires no correlation between the receiving and altering, as long as the two procedures both occur during detachment which it could, then the claimed limitations are met);

except:

b) specifying that the magnetic means is a magnet, an electromagnet comprised of a coil around a magnetic surface portion and said wireless communication device provides a voltage across said coil and the voltage is generated by an energy source comprised of a reservoir capacitor or a battery.

However, since Canada et al. teaches that the attachment means 404 in Fig. 2 can be a "magnetic mount", it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that such magnetic mount can be implemented as a mounting via magnetic force such as a conventional permanent magnet or conventional electromagnet such as a coil having a ferrous core and powered by an applied voltage across the coil (coil around a magnetic surface portion) whose voltage source can be supplied by onboard power supply source which is a battery, whereby the choice of using either one would have constituted functional equivalents. Furthermore, even though Canada et al. teaches that the magnetic mount is "self-contained" to facilitate mounting even in cramped locations (col. 5, lines 38-43), it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that when the magnetic means is implemented with an electromagnet, the magnetic mount can be self-contained with the device

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and still would allow mounting even in cramped locations since power is supplied from the power source of the wireless communication device and not from external connections that may hinder mounting in cramped locations.

6. Claims 7, 34, 64 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canada et al. in view of Thomson et al.(US pat. #4,754,532).

1) In considering claims 7 and 34, Canada et al. and Thomson et al. made obvious all of the claimed subject matter as stand in the previous Office action.

2) In considering claim 64, Canada et al. and Thomson et al. made obvious all of the claimed subject matter as in the consideration of claim 7 above, wherein:

--the claimed detaching the wireless communication device from the magnetic surface portion by activating a latch coupled to said magnet is met by Fig. 3 of Thomson et al. in which the adjustor 33 having portion 34 attached to magnet 36 constitutes the latch, protruding into cavity shown in the figure that prevents relative lateral movement of the assembly and its portions, and when retracting outward of the cavity, brings the magnet 36 with it away from the magnetic surface and thereby reducing its magnetic attraction and detaching the assembly from the magnetic surface.

3) In considering claim 67, Canada et al. and Thomson et al. made obvious all of the claimed subject matter as in the consideration of claim 7 above, wherein:

--the claimed detaching the wireless communication device from the magnetic surface portion comprising the step of bring said wireless communication device in proximity to a signal field generator (magnetic 36 in Fig. 3 of Thomson et al. generating magnetic fields), whereby

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when the magnet 36 is retracted outwardly of the cavity, the magnet 36 is moved away from the magnetic surface and thereby reducing its magnetic attraction and detaching the assembly and wireless communication it is attached to from the magnetic surface. Since the magnet 36 had to be proximate the magnetic surface before it can be retracted away from it, the claimed limitations are met).

Allowable Subject Matter

7. Claims 8-12, 14-22, 35-39, 42-46, 53-56, 58-60 are allowed.
8. Claims 65-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 13 and 40-41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 10/8/02 have been fully considered but they are not persuasive.

1) Regarding claims 23 & 57, while the Canada et al. reference itself was relied upon, conventional wisdom/practice also constitute sources of motivation/suggestion for modification. The rejection indicated that redundant or supplemental attachment means can be used, wherein adhesive was indicated to be one possible example. The claim is so broad that any means other than magnetic force used/present in the attachment can read on the claimed limitation. For that matter, a rough surface or particular shape of the magnet itself constitute a frictional force feature

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that is non-magnetic in facilitating attachment. Therefore, Applicant's argument is not deemed persuasive in overcoming the rejection.

2) Regarding claims 7 & 34, Fig. 3 of Thomson was used in the rejection. From the elements referenced in Applicant's argument, it appears that Applicant had misread the rejection and/or the Thomson reference. In any event, Fig. 3 of Thomson in combination with Canada as explained in the previous Office action rejection met all of the claimed features. In Fig. 3 of Thomson, magnet 36 moves in and out of a chamber in a plane perpendicular to the magnetic surface portion 11. Please refer to the disclosure of Fig. 3 of Thomson and Examiner's explanation in the rejection of claim 7 in the previous Office action.

3) Regarding new claims 74-77 (Applicant referred to them as new claims 69-72), while claim 74 is "similar" to allowed claim 19, they are not identical and therefore could be interpreted differently, and as a result, claims 74-77 are rejected. See above rejection of claims 74-77 for detail.

4) In conclusion, Applicant's arguments are not deemed persuasive in overcoming the rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (703) 306-4223.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Daniel Wu can be reached at (703) 308-6730. The fax phone numbers for the organization is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8576.


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.
December 7, 2002